



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/664,217 | 09/17/2003 | Stanley P. Sakowski | 47171-00405USPT | 3356 |

7590 09/13/2006

Jenkins & Gilchrist
A Professional Corporation
225 West Washington
Suite 2600
Chicago, IL 60606-3418

| EXAMINER |
|----------|
|----------|

BEAUCHAINE, MARK J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3653

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/664,217 | Applicant(s) SAKOWSKI, STANLEY P. | |
| | Examiner Mark J. Beauchaine | Art Unit 3653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/7/04;11/12/04;11/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The Applicant's submittals of Information Disclosure Statements filed on 7 June 2004, 12 November 2004 and 15 November 2004 are noted. With respect to the requirement for copies of submitted documents, the U.S. patent and published patent applications cited on the IDS submittals noted above have been considered, as submission of copies of these documents is no longer required. The non-patent literature and foreign documents now submitted and cited on the above IDS were also considered. Note that not all the documents listed on the PTO-1449 form have been received and the missing documents have been lined out on the attached PTO-1449. Should the Applicant provide documentary evidence (such as a petition decision) of a waiver of the 37 CFR 1.98(a) requirement for submission of copies of these documents, they will be considered to the extent that they can be readily accessed by the Examiner.

The Applicant's attention is directed to MPEP 2004, which provides assistance to Applicants in complying with the duty of disclosure. In particular, item 13 states:

It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F. 3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

Art Unit: 3653

While compliance with these guidelines is not mandatory, and there is no requirement to explain the materiality of cited references, the cloaking of a clearly relevant reference by inclusion in a long list of citations may not comply with an applicant's duty of disclosure, see *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, *supra*.

Optional and/or Suggestive Language

The use of optional and/or suggestive language "that does not require steps to be preformed or [] does not limit a claim to a particular structure" fails to limit the scope of the claim. (See M.P.E.P 2111.04.) The following terms are optional and/or suggestive, and thus, the claim language subject to said terms are given no patentable weight:

"adapted to" (claim 1, lines 4, 5, 8 and 10).

Claim Objections

Claims are objected to because of the following informalities:

The terms "determine denomination" (claim 1, line 8), "documents selectively faced" (claim 1, line 16) and "system as a volume" (claim 1, line 17) are improper grammar.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 11 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the operation of the facing and throughway sections and the relationship between said sections (lines 13-16) are ambiguous since it is unclear which section(s) selectively face currency documents.

Regarding claims 11 and 21, the term "storage cassette functionality" (line 2 of each claim) is ambiguous since it is unclear what feature(s) related to the function of a cassette is/are being referred to.

Regarding claim 19, the term "off sort output receptacle" (lines 14 and 15) lacks sufficient antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3653

Claims 1-5, 7-13, 17-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Number US 6,659,258 B2 by Otsuka ("Otsuka"). The processing system disclosed by Otsuka comprises housing 2, input receptacle 4, output receptacles 41-46, off sort output receptacle 51, evaluation unit 30 that is positioned between the input receptacle and the output receptacles and determined the denomination of a current document, transportation mechanism 14, etc. that comprises facing section 34 positioned upstream of the output receptacles. Said output receptacles are positioned below the transport mechanism. Said system further incorporates router G2 positioned to route currency bills to one of either facing section 34a or throughway section 35. Otsuka fails to disclose a processing system volume of less than about 25,000 square inches. The construction of a processing system having said maximum volume for the purpose of minimizing the space required to store and operate said system is an obvious design configuration absent any evidence demonstrating criticality of said volume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a housing of 25,000 square inches or less into the system of Otsuka for the purpose of minimizing the space required to store and operate said system.

Claim 6; and 14 and 15; and 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka as applied to claims 1, 7 and 17, respectively, above, and further in view of Patent Number 4,625,870 by Nao et al ("Nao").

Art Unit: 3653

Otsuka fails to disclose a user interface. Nao teaches user interface 4/5 for the purpose of permitting an operator to control the system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the user interface into the system of Otsuka for the purpose of permitting an operator to control the system.

Otsuka fails to disclose throughway and facing paths that are either substantially identical in length or transport currency at substantially identical transit times. Nao teaches a facing section comprising throughway path between router GR and receptacle 23a and facing path between router GR and receptacle 23b that are identical in length and transport currency at identical transit times for the purpose of selectively facing and transporting randomly oriented currency. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the facing section of Nao into the system of Otsuka for the purpose of selectively facing and transporting randomly oriented currency.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone

Art Unit: 3653

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjb

A handwritten signature in black ink, appearing to be 'PM' with a large loop, positioned above the printed name.

PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600